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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,235	01/13/2000	John L. Wood	OCR-729/756	6715

7590 04/11/2003

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
1624	

DATE MAILED: 04/11/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/482,235	Applicant(s) WOOD et al.
	Examiner Brenda Coleman	Art Unit 1624
		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Feb 7, 2003

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1, 3-5, 8-17, and 19-24 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1, 3-5, 8-17, and 19-24 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

6) Other: _____

Art Unit: 1624

DETAILED ACTION

Claims 1, 3-5, 8-17 and 19-24 are pending in the application.

This action is in response to applicants' amendment dated February 7, 2003. Claims 1, 13 and 17 have been amended.

Response to Arguments

Applicants' arguments filed February 7, 2003 have been fully considered with the following effect:

1. The applicants' amendments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejections of the last office action which are hereby **withdrawn**.
2. With regards to the 35 U.S.C. § 112, second paragraph rejection labeled 9a) of the last office action, the applicant's amendments and remarks have been fully considered but they are not persuasive.
 - a) The applicants' stated that "the process is directed to the preparation of furanosylated indolocarbazoles, not any glycosylated product". However, claims 1 and 17 indicate that the final structure at the end of each of the claims is a glycosylated product. If these are not glycosylated products as pointed out by the applicants, then why is the final structure described as "a glycosylated product having the ring structure"...

Art Unit: 1624

Claims 1, 3-5, 9, 10, 13-17 and 20-24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For reasons of record and stated above.

In view of the amendment dated February 7, 2003, the following new grounds of rejection and/or reinstated rejections apply:

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3-5, 8-17 and 19-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to the process of claims 1, 13 and 17 where all of the R variables were removed leaving structures which appear to be permethylated derivatives is not described in the specification.

Applicant is required to cancel the new matter in the reply to this Office action.

4. Claims 1, 3-5, 8-17 and 19-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application

Art Unit: 1624

was filed, had possession of the claimed invention. The amendment to the process of claims 1 and 17 where the 2nd acetal moiety contains C=X- where X is S or O is not described in the specification. This moiety in the specification is only described where a nitrogen atom is double bonded to the carbon atom.

Applicant is required to cancel the new matter in the reply to this Office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3-5, 8-17 and 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claims 1, 3-5, 9, 13-17 and 20-24 are vague and indefinite in that it is not known what is meant by the various structures which appear to be permethylated, i.e. all of the letter R's have been removed. The structures appear to be incomplete where the applicants have removed all of the R groups in view of the irrelevancy urged in the process claims.
- b) Claim 8 recites the limitation "hydrogens and methoxys" in the furanose structure. There is insufficient antecedent basis for this limitation in the claim. The structure of the acetal in claim 1 indicates that the structure is permethylated.

Art Unit: 1624

- c) Claim 8 recites the limitation "DMB, hydrogens and methoxys" in the structure of the final product. There is insufficient antecedent basis for this limitation in the claim. The structure of the final product in claim 1 indicates that the structure is permethylated
- d) Claim 11 recites the limitation "hydrogens and methoxys" in the structure of K252a. There is insufficient antecedent basis for this limitation in the claim. The structure of the final product in claim 1 indicates that the structure is permethylated.
- e) Claim 12 recites the limitation "hydrogens and methoxys as well as a hydroxymethyl" in the structure of the three species. There is insufficient antecedent basis for this limitation in the claim. The structure of the final product in claim 1 indicates that the structure is permethylated.
- f) Claim 16 recites the limitation "hydrogens" in the structure of the 2,2'-biindole. There is insufficient antecedent basis for this limitation in the claim. The structure of the biindole in claim 13 indicates that the structure is permethylated.
- g) Claim 17 is vague and indefinite in that it is not known what is meant by the R variable in the indolecarbazole which is not defined within the claim.
- h) Claim 19 recites the limitation "hydrogens and methoxys" in the structure of K252a. There is insufficient antecedent basis for this limitation in the claim. The

Art Unit: 1624

structure of the final product in claim 17 indicates that the structure is permethylated.

The following 35 USC § 102 rejections are herein reinstated in view of the applicants remarks. In re Wiggins 179 USPQ 421.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-5, 8-17 and 19-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al., Tetrahedron Letters. Wood teaches the process and the product by process of the instant invention. See reaction Scheme 1 and the first paragraph which states that "the enantioselective synthesis of (+)-K252a [5] via an approach involving the late-stage coupling of aglycon 8 and furanose 9".

7. Claims 1, 3-5, 8-17 and 19-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al., Journal of the American Chemical Society. Wood teaches the process and the product by process of the instant invention. See reaction Scheme 1 and paragraphs 1 and 2 which teaches the reaction of compounds 6 and 3 to obtain 1 and the reaction of compounds 4 and 5 to obtain 3.

Art Unit: 1624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Brenda Coleman
Brenda Coleman
Primary Examiner AU 1624
April 10, 2003